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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,067	08/20/2001	Steve Brandstetter	P/94-1	6703
7590	05/25/2006		EXAMINER	
Philip M. Weiss, Esq. Weiss & Weiss Suite 251 300 Old Country Road Mineola, NY 11501			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	
DATE MAILED: 05/25/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/933,067	BRANDSTETTER ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 15 May 2006.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-9, 11-13 and 16-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9, 11-13 and 16-18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 20 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of the previous rejection is incorporated herein by reference. The rejection of claims 14 & 15 are hereby incorporated into the rejection of claim 12. This reflects the cancellation of these claims and addition of their limitations into claim 12.

### ***Response to Arguments***

3. Applicant's arguments filed 15 May 2006 have been fully considered but they are not persuasive.

4. As in the previous response, Applicant argues (repeatedly) that Okuniewicz teaches a bonus that is randomly generated based on an event that takes place on the slot machine and upon which the player is unaware. This argument is based on an incorrect reading of the reference. Okuniewicz makes it clear that the result of the bonus (i.e., the result of the lottery) is the random bonus. (Col 1, 55-60) There is no suggestion in Okuniewicz that the dispensing of the ticket must be random. In fact, since Okuniewicz teaches that the tickets may regularly be awarded based on amounts wagered, it is clear that Okuniewicz contemplates at least one embodiment in which the award of the ticket is not random.

5. Applicant argues that there is no reason to combine Okuniewicz and Quinn. This argument is based on Applicant's erroneous interpretation of the Okuniewicz reference.

6. Applicant argues that Okuniewicz does not teach showing the player when a ticket will be generated. Again, this was answered in the previous office action. For over 100 years, slot machine operators have been notifying players when they may expect a payout or a prize. This is called a payable. They are conspicuously posted on the slot machine. Paytables are so well known that it is not considered necessary to mention the display of one in every slot machine patent – if they are not inherent, they are virtually inherent.

7. Again, Applicant is basing his arguments on a faulty interpretation of Okuniewicz. Anyone who plays Okuniewicz's machine for any length of time will not be surprised when it dispenses the lottery ticket – even if no tickets are mentioned on the payable. Okuniewicz teaches dispensing lottery tickets regularly (i.e., upon the insertion of a certain number of coins) or as a result of certain combinations on the reels. Players would soon figure this pattern out. (Player: "Every time Orange-Lemon-Cherry come up, the machine dispenses a ticket – that means that Orange-Lemon-Cherry is a combination that awards a ticket..." Or, "Every time I put 20 coins into the machine, I get a ticket. I've put in 19 coins. This is 20. Yep, here's the ticket. Just as I expected...") In short, there is absolutely no reason that Okuniewicz should not post the criteria for awarding a ticket on the payable – players (who usually know how to count and can often figure out cause and effect) would soon figure it out anyway. Plus posting the criteria would have benefits because doing so would let the player know that the tickets are available.

### *Conclusion*

8. This is an RCE of applicant's earlier Application No. 09/933,067. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier

application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

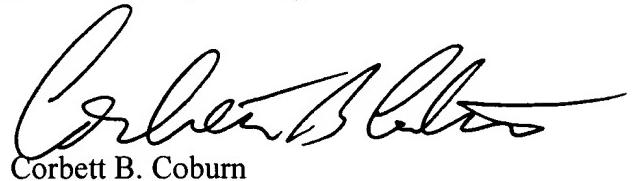
9. Applicant appears to have cancelled claims 14 & 15 and placed these limitations in the independent claim. These claims were already rejected and the amendment did nothing to distinguish over the prior art. Thus the amendment cannot be said to have been a *bona fide* attempt to advance prosecution. Thus it is proper to make this action final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn  
Primary Examiner  
Art Unit 3714

**CORBETT B. COBURN  
PRIMARY EXAMINER**